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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/669,056	06/24/1996	BRUCE NACHMAN	INFINITY-3.0	1657

7590

08/13/2003

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EXAMINER

LEE, CHEUKFAN

ART UNIT

PAPER NUMBER

2622

DATE MAILED: 08/13/2003

34

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/669,056

Applicant(s)

Nachman

Examiner

Cheukfan Lee

Group Art Unit

2622

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE (1) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 5-23-03
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 27-29, 32-48, and 52-54 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 2622

1. Claims 27-29, 32-38, and 52-54 are pending. Claims 27, 28, 36, 43, 52, 53, and 54 are independent.

2. The restriction requirement set forth in the last Office action is improper and therefore is withdrawn. A new restriction requirement follows. Applicant's election with traverse of invention I in Paper No. 33 is acknowledged. The examiner found the traverse persuasive in part that inventions I and III should be grouped together. However, the traverse on the ground that all inventions I, II and II should be grouped together is not found persuasive.

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 27, 29, 32-34, 4~~1~~⁴⁰, 36, 38-4~~0~~⁴⁰, 42, 43-48, 52, 53, 35, and 54, drawn to a facsimile machine (Fax) and a personal computer (PC) for scanning and printing, classified in class 358, subclass 442.
- II. Claims 28 and 37, drawn to establishment of transmission state within PC and Fax connection, classified in class 358, subclass 434.

4. The inventions are distinct, each from the other because:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the

Art Unit: 2622

subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the using of the Fax and PC to scan and print in invention I does not require the type or types of connections specified in invention II including the initiation(s) specified. The subcombination has separate utility such as initiation of connection between a Fax and a PC which are not used to scan and print a document as the Fax and PC of invention I do.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheukfan Lee at telephone number (703) 305-4867.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 872-9314 (for formal communications intended for entry)
(703) 308-5397 (for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two
2121 Crystal Drive
Arlington, VA
Sixth Floor (Receptionist)

C. L.
Aug. 8, 2003


Cheukfan Lee